

## **REMARKS**

In the Decision of the Board of Patent Appeals and Interferences dated October 26, 2006 the rejections of claims 1-9, including the rejection of claims 1-4 and 9 under 35 U.S.C. §103(a) as obvious over Saito and Fenster, were affirmed. Applicants submit, however, that the affirmance of the rejection of claim 3, as evidenced by statements made by the Board in the October 26, 2006 Decision, was due to the fact that the Board was constrained by the procedural formality of the rejection of claim 3 not having been separately argued in the appeal. Applicants submit certain statements of the Board, discussed below, in the October 26, 2006 Decision indicate that the Board was skeptical of the propriety of the rejection of claim 3 the present RCE has been filed wherein the subject matter of claim 3 (and thus the subject matter of claim 2 as well) has been embodied in independent claim 1, and claims 2 and 3 have been cancelled. Reconsideration of the rejection of the subject matter of claim 3, now embodied in independent claim 1, is therefore respectfully requested.

In substantiating the rejection of the previous version of claim 1 that was the subject of the appeal, the Examiner acknowledged that the Saito reference does not disclose the limitation of claim 1 of the image system selecting a control function, from among a plurality of different control functions respectively uniquely associated with different predetermined movement directions of the mouse, by detecting movement of the mouse in one of those predetermined directions and then selecting the control function that is uniquely associated with that direction, in order to alter the display of the image at the display unit. The Examiner relied on the Fenster reference as providing such a teaching on the basis of the Fenster reference

teaching rotation of the displayed image around respectively different axes dependent on the direction that the mouse cursor is being dragged on the screen. The Examiner stated that since this rotation differs depending on which direction the mouse cursor is moved, this corresponded to the language of claim 1 that was the subject of the appeal.

Although the Board agreed with this position of the Examiner, the Board, at page 4 of its Decision, noted that the limitations of claim 3 were mentioned in Appellants' Reply Brief at pages 4-5. Since claim 3 had been included among all of the claims previously rejected based on the Saito/Fenster combination, Applicants did not separately argue claim 3 in the appeal. As explicitly stated in the Appeal Brief, the reference to the limitations of claim 3 were simply provided as examples of the different control functions referred to in claim 1. This was for the purpose of emphasizing or clarifying Applicants' arguments on appeal, to the effect that the control functions referred to in claim 1 were truly respectively different control functions, rather than a single control function that produces differing outputs when supplied with differing inputs.

The undersigned representative of the Applicants was asked at the oral hearing for the appeal as to whether the aforementioned citation of claim 3 in the Reply Brief was intended as an argument for the separate patentability of claim 3, and the undersigned representative answered that it was not, but was, as stated above, simply a convenient location where examples of the different control functions referred to in claim 1 could be found.

In view of this interest expressed by the Board at the oral hearing, Applicants there is a plausible basis to believe that had the subject matter of claim 3 been argued separately in the appeal, the Board may have been favorably disposed to reversing the rejection of claim 3, while still affirming the rejection of claim 1.

Moreover, the Examiner's previous rejection of claim 3 may have been based on the fact that the language previously used in claim 3 was in the form of a Markush group that included, as one of the Markush elements, rotating the displayed image. Applicants acknowledge that when examining a Markush group, if the Examiner is able to locate one element of the group in the prior art, this is a justifiable basis for rejecting the entire Markush claim. In re-writing the subject matter of claim 3 into independent claim 1 herein, therefore, Applicants have not expressed the different control functions as a Markush group, but have stated that the different control functions that are uniquely associated with the different mouse movement directions are, in fact, the three control functions that were set forth in original claim 3.

Therefore, despite the fact that one of these control functions is rotating the display, which Applicants acknowledge is disclosed in the Fenster reference, the other two control functions, even though admittedly being generally known types of control functions, are not disclosed in the Fenster reference, and more importantly, are not disclosed in the Fenster reference or any other reference, as being uniquely associated with different directions of movement of a mouse cursor.

Applicants therefore submit that the subject matter of amended independent claim 1 is not disclosed or suggested in the combined teachings of Saito and Fenster, and therefore the subject matter of amended independent claim 1 would not have been obvious to a person of ordinary skill in the field of designing computerized

control and display systems, based on the teachings of those references.

Reconsideration of the application is therefore respectfully requested.

Submitted by,



(Reg. 28,982)

---

SCHIFF, HARDIN LLP  
**CUSTOMER NO. 26574**  
Patent Department  
6600 Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606  
Telephone: 312/258-5790  
Attorneys for Applicants.

CH1\ 4796002.1